

### **REMARKS**

The Final Office Action mailed February 6, 2009 and the references cited therein have been carefully considered. Claims 1-24 are now pending in the application. Claims 1 and 21 have been amended to incorporate the subject matter of dependent Claim 4, which is hereby cancelled.

Applicants respond to the issue raised in the subject Office Action more specifically below and respectfully requests reconsideration of the pending rejections.

#### **Claim Rejections under 35 USC § 102**

In the Office Action, Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by British (UK) Patent No. 2,326,375 to **Garrard**. It is submitted that this rejection has been rendered moot by the amendments submitted herein. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 102(b).

#### **Claim Rejections under 35 USC § 103**

Claims 1-4, 6-9, 16-17 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,808,792 to **Weber** in view of **Garrard**. Additionally, Claim 5 is rejected as being unpatentable under 35 U.S.C. §103(a) over **Weber** in view of **Garrard** and further in view of U.S. Patent No. 5,103,583 to **VanErmen**. Further, Claims 10-15, 18-20 and 22-24 are rejected as being unpatentable under 35 U.S.C. §103(a) over **Weber** and

**Garrard** and further in view of U.S. Patent No. 4,533,160 to **Malone**. Applicants respectfully traverse these rejections as set forth more fully below.

Weber discloses a transfer foil with at least one lacquer layer and a heat-activated adhesive layer (see, Weber column 1, lines 11-14). While Weber suggests that a transfer foil can be used to apply a decorative layer to a multi-page document, such as a passport, it does not teach or suggest fixing the transfer foil itself to the document. Also, it is essential to Weber that the transfer layer be removable from the carrier film under the effect of heat, since the disclosure describes the use of a heat-activated adhesive layer (see, Weber Claim 1). It should be noted that in Weber the decorative layer arrangement that is transferred is intended to be visible. That decorative layer is described as including “structures having an optical-diffraction or holographic effect” (see, Weber Col. 1, lines 21-23). Moreover, the decorative layer is further described as usually including “at least one lacquer layer and a layer of a heat-activatable adhesive which serves to join the lacquer layer or assembly of lacquer layers which represent the actual security element” (see, Weber Col. 1, lines 25-32). A person of ordinary skill in the art would have no reason or motivation to depart from this fundamental teaching which requires such a heat-activated adhesive layer in addition to the one or more lacquer layers forming the visible security features. In contrast, Garrard discloses a passbook using a totally different kind of foil for a completely different purpose, i.e. the use of a "carbon paper" for the application of an "invisible" signature in/on a passbook. It is abundantly clear that the foil disclosed by Weber cannot be used for the purpose described by Garrard. In particular, the foil of Weber requires heat activation for

transfer of its multi-layers and therefore cannot be used like carbon paper. Simply using a pen or applying pressure will not activate and transfer the Weber foil. Additionally, Weber's security elements remain visible, which is directly contrary to the type of transfer paper needed for the Garrard passbook. The function of the passbook disclosed by Garrard would be rendered useless if the transfer film did not transfer an invisible impression.

Applicants traverse the characterization in the subject Office Action that Garrard simply teaches binding a transfer film into a booklet, as if all transfer films are alike and have the same purpose. Rather, Garrard is limited to the transfer or conversion of a person's signature into one that is not visible, except when viewed under a UV lamp. In particular, Garrard describes a passbook carrying the signature of the account holder applied in a UV-fluorescent material, which can be made visible by an UV lamp for the verification of the account holder's signature at the bank counter and can be used for verification purposes (see, Garrard page 1, second paragraph). In Garrard, there is no reason for the removable page unless it provides the account holder a means for converting a traditional pen and ink signature into an "invisible ink" signature. Garrard does not disclose or reasonably suggest transferring anything other than a signature. What Garrard does disclose is a passbook with a cover 4 and several transaction pages 6. The transaction pages 6 are sewn to the cover via a sub-cover with stitches 8 to which the actual cover is laminated. Furthermore, the passbook comprises a security sheet 10, which is also sewn into the cover and which is coated in one area 12 with a transfer material consisting of a pressure-sensitive UV-material (see, Garrard Fig., page 2, 2<sup>nd</sup> and 3<sup>rd</sup> paragraph). Optionally, a

line 14 is printed on the security sheet 10, which shows the account holder where to sign.

Garrard teaches that the security sheet 10 is fixed to the cover of the passbook so that when the account holder performs the act of signing, he/she does not need to hold it in place when signing. During the act of signing, the UV-luminescent material is transferred to one area of the inside cover in those areas where pressure is applied. In this way an "invisible" signature of the account holder is thereby recorded. Thus in Garrard, the security sheet 10 acts like a special carbon paper that transfers invisible ink. Afterwards, the security sheet 10, including area 12, is removed from the passbook along the perforation caused by the seam (see Garrard page 2, last paragraph).

Thus, the underlying process as disclosed by Garrard is fundamentally different from the process described in the subject application. In the subject application the individualized print is directly applied to the passport page and then covered by the transfer element by means of its integrated transfer film. In Garrard, the individualization is performed by transfer of ink. In the present patent application, a layer arrangement is provided consisting of a base film, a permanent adhesive layer, a carrier layer, a release layer and a decorative layer with an adhesive layer, as recited in amended Claims 1 and 21. Applying the teachings of Garrard, one of ordinary skill in the art would not replace the layer consisting of the UV-fluorescent material with such a complex layer arrangement as taught by Weber. To attempt the systematic removal of only a small areas of the multi-layer arrangement, by applying pressure with pen, would be very difficult and probably would not work, due to the tenacity of the individual layers, especially of

the separate adhesive layer. More notably, it would not be possible to transfer a portion of a foil as disclosed by Weber in the areas where pressure is applied with a pen. Thus, one of ordinary skill in the art would have more than one reason for not doing so. In particular, the Weber film would not work to transfer an invisible version of a customer's signature. Also, transferring the visible security elements of the Weber film runs contrary to the reason Garrard provides UV material.

One of ordinary skill would have no reason or suggestion to replace the UV material in Garrard with a transfer film as disclosed by Weber. Also, there is no reason or suggestion in Weber to apply that type of transfer film having a heat-activated adhesive layer to a removeably secured sheet in the passbook of Garrard. Accordingly, it would not have been obvious to combine Weber and Garrard to arrive at the claimed invention as recited in the claims.

Additionally, neither VanErmen nor Malone teach or suggest the missing elements, or disclose or suggest a motivation to combine Weber and Garrard. In particular, neither VanErmen nor Malone teach or reasonably suggest incorporating a transfer film, as claimed, into a multi-page document by the same means of fixing or adhesive that joins the pages of the document. Accordingly, both VanErmen and Malone individually or in combination with Weber and Garrard fail to teach or reasonably suggest all the elements of the claimed invention, particularly Claims 1 and 21.

Applicants submit that the amended claims, particularly independent claims 1 and 21, are clearly distinguishable from the cited prior art references. Also, claims 2, 3 and 5-20 and claims

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22-24, which ultimately depend from Claims 1 and 21, respectively, are similarly patentable over the art of record by virtue of their dependence. Also, Applicants submit that Claims 2, 3 and 5-20 and claims 22-24 define patentable subject matter in their own right. In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and allowance of the claims presented. Accordingly, Applicants hereby respectfully request reconsideration and withdrawal of the current rejections of the claims under 35 U.S.C. §103(a) as being unpatentable over Weber, Garrard, VanErmen or Malone, alone or in combination.

If the Examiner has any questions or suggestions to expedite allowance of this application, she is cordially invited to contact Applicants' attorney at the telephone number provided.

Respectfully submitted,

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